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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/512,829 02/25/00 GARVEY

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EXAMINER

025270

HM12/0619

EDWARD D GRIEFF

HALE & DORR LLP

1455 PENNSYLVANIA AVE, NW

WASHINGTON DC 20004

RAD.D

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

06/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/512,829

Applicant(s)

Garvey et al.

Examiner

Deepak Rao

Art Unit

1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Apr 9, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-78 are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 1-78 are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

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### **DETAILED ACTION**

Claims 1-78 are pending in this application.

Upon reconsideration, the restriction has been revised as follows:

#### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-34, 56-58, 62-63, 65, 67, 69-70 and 73-75, drawn to a compound of formula (I), corresponding compositions, methods of use and kit, classified in class 546/548, subclass various.
- II. Claims 1-34, 56-58, 62-63, 65, 67, 69-70 and 73-75, drawn to a compound of formula (II), corresponding compositions, methods of use and kit, classified in class 546, subclass various.
- III. Claims 1-34, 56-58, 62-63, 65, 67, 69-70 and 73-75, drawn to a compound of formula (III), corresponding compositions, methods of use and kit, classified in class 544, subclass various.
- IV. Claims 1-34, 56-58, 62-63, 65, 67, 69-70 and 73-75, drawn to a compound of formula (IV), corresponding compositions, methods of use and kit, classified in class 548, subclass various.

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- V. Claims 1-34, 56-58, 62-63, 65, 67, 69-70 and 73-75, drawn to a compound of formula (V), corresponding compositions, methods of use and kit, classified in class 546, subclass various.
- VI. Claims 1-34, 56-58, 62-63, 65, 67, 69-70 and 73-75, drawn to a compound of formula (VI), corresponding compositions, methods of use and kit, classified in class 548, subclass various.
- VII. Claims 1-34, 56-58, 62-63, 65, 67, 69-70 and 73-75, drawn to a compound of formula (VII), corresponding compositions, methods of use and kit, classified in class 546, subclass various.
- VIII. Claim 1, drawn to a proton pump inhibitor compound other than those of Groups I-VII, classified in class /subclass various (depending on the structural features of the compounds).
- IX. Claims 35-55, 59-61, 64, 66, 68, 71-72 and 76-78, drawn to a composition, corresponding method of use and kit, classified in class /subclass various.

The inventions are distinct, each from the other because of the following reasons:

The compounds of Groups I-VIII are drawn to structurally dissimilar compounds. They are made independently and used independently. They would be expected to raise different issues of patentability if a compound of Group I, consisting of a benzimidazolyl radical were anticipated, the anticipatory reference would not necessarily render obvious the other groups II-VIII or vice-versa. They are not art recognized equivalents, they are classified diversely and require separate

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searches in the literature and computer databases, and therefore the search required is burdensome.

The inventions of Groups I-VIII and IX are drawn to compositions having different active ingredients, e.g., the composition according to invention of Groups I-VIII contains nitrosated, nitrosylated or nitrosated and nitrosylated compounds which is different from that of Group IX.

**Note:** Restriction between Groups I-VIII and Group IX is consistent with the restriction groups proposed by applicants, see page 2 of the response filed on April 9, 2001, i.e., applicants proposed Group I is now Groups I-VIII and Group II is now Group IX. As the claim distribution within each group is different from that recited in applicants' response, a written restriction requirement is submitted, such that applicants have an opportunity to review the groups.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

In addition to election of one of the groups above, applicant is required under 35 U.S.C. 121 to elect **a single disclosed species falling within the elected group**, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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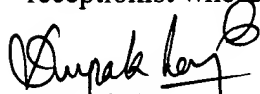
examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
Deepak Rao  
June 18, 2001